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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,780	01/22/2001	Michael J. Sullivan	P-5686U1-D1 SLD 2 0106-2	8351
7590	03/05/2003			
Senior Patent Counsel Spalding Sports Worldwide, Inc. 425 Meadow Street PO Box 901 Chicopee, MA 01021-0901			EXAMINER GORDON, RAEANN	
		ART UNIT 3711	PAPER NUMBER	

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)
	09/766,780	SULLIVAN ET AL.
	Examiner Raeann Gorden	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 December 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Objections

Claims 10-18 are objected to because of the following informalities: claim 10. line 6 'and' should be 'an'. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamagishi et al (5,688,595). Regarding claim 1, Yamagishi discloses a golf ball comprising a dual core and a single outer cover. The dual core comprises a center component (12) and a core layer (13) (fig 2). The center component is made from a thermoset material and the core layer is made from a thermoplastic. The outer cover layer has a Shore D hardness from 40 to 60. Regarding claim 2, 4, and 6, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer. Regarding claim 3, the core may comprise of

at least two layers (col 2, lines 57-60). Regarding claim 7, the center component has a diameter from 0.787 to 1.535 inches and the core component and core layer have a diameter from 1.378 to 1.614 inches. Regarding claims 8 and 9, Yamagishi discloses a variety of inert fillers that may be added to the core layers that are commonly known for increasing/decreasing density (col 5, lines 1-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi (5,688,595) in view of Wu (5,334,673). Yamagishi discloses the invention as shown above but does not include polyurethane as an option for the thermoset material (core component). However, Wu teaches a polyurethane golf ball product suitable for the core layer. One skilled in the art would have modified the invention of Yamagishi by including a polyurethane core component to improve the resiliency of the golf ball.

Claims 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al (5,688,595) in view of Maruko et al (5,752,888). Regarding claim 10, Yamagishi discloses a golf ball comprising a dual core and a single outer cover. The dual core comprises a center component (12) and a core layer (13) (fig 2). The center component is made from a thermoset material and the core layer is

made from a thermoplastic. The outer cover layer has a Shore D hardness from 40 to 60. Regarding claim 11, 13, and 15, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer.

Regarding claim 12, the core may comprise of at least two layers (col 2, lines 57-60).

Regarding claim 16, the center component has a diameter from 0.787 to 1.535 inches and the core component and core layer have a diameter from 1.378 to 1.614 inches.

Regarding claims 17 and 18, Yamagishi discloses a variety of inert fillers that may be added to the core layers that are commonly known for increasing/decreasing density (col 5, lines 1-9). Yamagishi does not disclose an inner cover layer with a Shore D hardness greater than 60 or more as in claim 10. Maruko teaches an inner cover layer with a Shore D hardness greater than 60 and an outer cover layer Shore D hardness from 43 to 53. One skilled in the art would have modified the hardness of the inner cover layer to achieve the desired flight characteristics of the golf ball.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi (5,688,595) in view of Maruko'888 as applied to claims 10-13 and 15-18 above and in further view of Wu (5,334,673). Yamagishi in view of Maruko discloses the invention as shown above but does not include polyurethane as an option for the thermoset material (core component). However, Wu teaches a polyurethane golf ball product suitable for the core layer. One skilled in the art would have modified Yamagishi in view of Maruko by including a polyurethane core component to improve the resiliency of the golf ball.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are not persuasive. Applicant has amended claim 1 to include a single cover layer. The rejection over Yamagishi is maintained since applicant does not exclude the possibility of an additional cover layer by claiming 'a cover includes a single cover layer' as oppose to 'a cover consisting of a single layer'. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a golf ball comprising an inner cover layer harder than the outer cover layer is well established and known in the art. The hard inner cover layer provides high initial velocity and the soft outer cover layer ensures good spin and feel upon impact (Maruko col 4, lines 8-13). In response to applicant's argument that the Wu reference is directed to a polyurethane cover applicant's attention is directed to column 2, lines 33-39. Wu teaches the polyurethane golf product is suitable for cores and cover layers. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

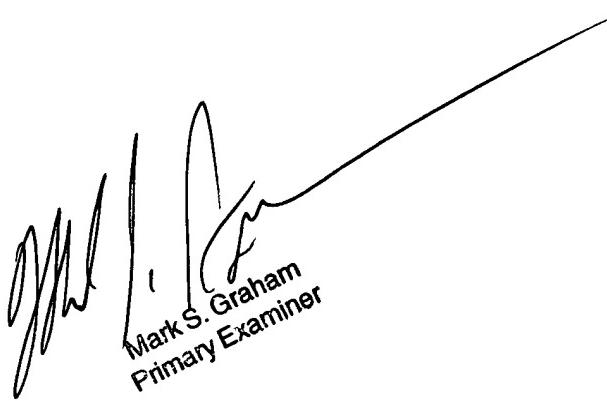
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is (703) 308-8354. The examiner can normally be reached Monday-Fridays from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on 703-308-2126. The fax number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

rg
February 26, 2003



A handwritten signature in black ink, appearing to be "Mark S. Graham". Below the signature, the text "Primary Examiner" is written in a smaller, cursive font.